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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,223	06/27/2001	Shane M. Kelton	163.1062USD1	5643
7590	06/01/2004		EXAMINER	
DAVID R. CLEVELAND IPLM GROUP, P.A. POST OFFICE BOX 18455 MINNEAPOLIS, MN 55418			DICUS, TAMRA	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 06/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/893,223

Applicant(s)

KELTON ET AL.

Examiner

Tamra L. Dicus

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 15 March 2004.

2a) This action is FINAL.                  2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-35, 37-47 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 38-42 and 45-47 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)

4)  Interview Summary (PTO-413)

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

Paper No(s)/Mail Date. \_\_\_\_\_ .

3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)

5)  Notice of Informal Patent Application (PTO-152)

Paper No(s)/Mail Date \_\_\_\_\_ .

6)  Other: \_\_\_\_\_ .

**DETAILED ACTION**

This Office Action is responsive to the amendment filed 03-15-04.

***Claim Objections***

The amendment filed 11-03-03 stands objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure for reasons of record as previously set forth in Paper No. 16 mailed 12/18/2003.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 45-47 and 38-42 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement for reasons of record as previously set forth in Paper No. 16 mailed 12/18/2003.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 38-42 and 45 stand rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,314,554 to Owens for reasons of record as previously set forth in Paper No. 16 mailed 12/18/2003.

***Specification***

The disclosure is objected to because of the following informalities: the specification includes new matter e.g. floor tile 11a and tile core 78 descriptions.

Appropriate correction is required.

The amendment filed 03-15-04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: floor tile 11a and tile core 78 descriptions were not originally provided for anywhere within the specification as originally filed. Additionally, floor tile 11a nor tile core 78 were originally included in Figure 6.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Response to Arguments***

Applicant's arguments filed 3-15-04 have been fully considered but they are not persuasive. Applicant's allegations toward support in the original specification is not founded. Applicant contests the claim objection under 132 over new matter within the specification. Applicant points to the traffic surface described at pg. 3, line 4-pg. 5, line 4 where it states "After a short time, the quarry tile is subjected to abrasion and surface wear due to foot traffic," which simply discusses what could generally happen to new quarry tile and does not teach Applicant's final product of a treated quarry tile as Applicant now explains. Applicant also attempts to point

Art Unit: 1774

to a traffic surface and core in original Figure 6. However, as the Examiner stated previously, original Figure 6 does not reference an underlying core in conjunction with a traffic surface. Applicant further argues they “should not be required to describe ‘how to make the underlying core’-that is the province of the quarry tile manufacture.” The Examiner previously stated this because there is no description as originally filed that discloses an underlying core in conjunction with a floor traffic surface-hence the reasoning for the new matter rejection. Applicant does not originally disclose an “underlying core” nor its relationship to a floor traffic surface as filed regardless of how it is made. It would be necessary for Applicant to explain his underlying core and its relationship to other layers, regions, or surfaces because the pictures didn’t match what the claims and specification said, which needs to be clarified. Hence, the application as originally filed does not provide adequate support for the instant claims. Applicant has not removed the new matter and thus is still in violation of 35 U.S.C. 132. Because the Applicant has not removed the new matter, the objection is maintained for reasons set forth above.

Applicant is urged to cancel the new matter. Applicant further points to “details” of a tile core found at pg. 49, line 10-page 51, line 18, however this tile core is a new core and not a description of Applicant’s instant invention. This description of a core is merely used in comparative fashion. Applicant describes therein a “core of new, untreated quarry tile”, which contradicts Applicant’s statement that the instant invention is to “a treated tile”. Therefore the core described a pp. 49-51 cannot be the core with a treatment as applicant argues is their instant invention. Further, Applicant now attempts to overcome the drawing objection by introducing new matter within the original specification, which is in violation of 35 U.S.C. 132. Thus

Art Unit: 1774

following, the 112 1<sup>st</sup> paragraph rejection is maintained because the claims still contain new matter that is not consistent with the originally filed specification.

Applicants argue the 112 1<sup>st</sup> paragraph rejection, alleging support is shown as originally filed. However, as previously stated, an underlying core was not originally presented as part of the instant invention. There are no processes that describe an underlying core made in conjunction with a flooring traffic surface that make applicant's instant invention. Therefore, the 112 1<sup>st</sup> paragraph rejection is upheld.

Applicant argues the 103 rejection alleging Owens does not provide a tile with the same material used in the underlying core and upper layers. However, while Owens does include other layers above layer (4), Applicant does not exclude additional layers because Applicant employs the term "comprising", which could very well include additional layers. Owens still provides for an underlying quarry tile having a floor traffic surface of substantially the same elemental composition as the underlying core because the quarry layer (4) inherently has a floor traffic surface and this surface is of the same material as Applicant, e.g. quarry, and therefore functions in the same manner. Quarry tile (4) of Owens inherently has an underlying core (underlying region) and flooring surface (upper region) because layer (4) has a thickness. All the properties that Applicant claims e.g. microscopic peaks and valleys and slip-resistance are all inherent to the composition of quarry. As previously set forth, per Applicant's own admission at page 3, lines 5-6 the quarry tile naturally has microscopic peaks.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 1774

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 24, 2004

[tld]

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

A handwritten signature in black ink, appearing to read "Cynthia H. Kelly".